



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/627,181	07/27/2000	Manfred Fries	GR 98 P 1075	1252

7590 02/11/2003

Lerner and Greenberg PA
Post Office Box 2480
Hollywood, FL 33022-2480

EXAMINER

KIM, AHSHIK

ART UNIT	PAPER NUMBER
----------	--------------

2876

DATE MAILED: 02/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/627,181

Applicant(s)

FRIES ET AL.

Examiner

Ahshik Kim

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/22/02 (Amendment).
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 2876

DETAILED ACTION

Receipt of Response

1. Receipt is acknowledged of the response filed on December 24, 2002. The Applicant
5 stated in remarks section that claims 1-18 remain in the application. It is noted that claims 1-8
have been presented in the original application, and no claims have been canceled or added
thereafter. Accordingly, claims 1-8 remain for examination.

Claim Rejections - 35 USC § 102

10 The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the
basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

15 (b) the invention was patented or described in a printed publication in this or a foreign
country or in public use or on sale in this country, more than one year prior to the date of
application for patent in the United States.

2. Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Hiramatsu (US
5,180,901).

20 Re claims 1, 2, 4-6, and 8, Hiramatsu teaches an IC card (or smart card) 10 for biometric
authentication, comprising at least one sensor: a pressure sensor 1, and an authentication sensor 3
(col. 4, lines 13+) installed in the respective openings. The pressure sensor 1 includes pressure-
sensing electrodes 14 (col. 5, lines 40+; see figure 6) and the authentication sensor 3, which is
comprised of various circuitries such as light emitting diodes 17 (col. 5, lines 62+; see figure 7).
The card is in the form of ATM card or a typical credit card (col. 1, lines 20+) further disclosing

Art Unit: 2876

dimensional measurement of a card and other data-carrying medium such as embossed characters, magnetic/optical/IC storage, which can be integrated into the card. As further disclosed in figure 3, the card contains microprocessor 9, A/D converter 2, and various circuitries for image capturing, pressure sensing and authentication process (col. 4, lines 57+), and the component parts are connected in order to perform the mentioned tasks above.

Re claims 3 and 7, as shown in figure 5, the card is layered with a silicon substrate 15, a diaphragm 16, and a base layer 13 (col. 5, lines 27+). Although the base layer 13 is glass, a conventional ATM/credit card utilizes various polycarbonate materials.

10

Response to Arguments

3. Applicant's response filed on December 24, 2002 has been fully considered, but they are not persuasive.

15

Applicant argues that the reference to Hiramatsu (US 5,180,901) directly integrated sensor chips into chip cards. Applicant further argues that this kind of chip card does not have a chip card module (See page 2, 4th paragraph of the Response).

The Examiner respectfully disagrees with the Applicant's assertion. The IC card disclosed in Hiramatsu has many chip card modules. In fact, all component parts of the IC card to perform authentication function (i.e., pressure sensor 1, authenticity sensor 3, external contact 11 etc.) are all chip card modules.

20

Although Hiramatsu provides a great detail in steps of capturing fingerprint image and authenticating data, the reference is relatively silent on construction or structure of the card. The reference, however, does not mention that all parts are directly integrated into card body as

Art Unit: 2876

suggested by the Applicant. Looking at figures, the card body provides necessary cavities for the component parts to be mounted. Thus, if needed, the parts may be un-installed. The cavities also provide support for the component parts, and it is inherent that the parts are electrically connected to perform designed functions.

5 Perhaps, the Applicant might have meant to claim an IC card wherein the component modules are readily moveable (i.e., modules can be taken out from or pushed into the openings). Even if such elements were disclosed and claimed in the application, it is the Examiner's view that integrating component parts and modularizing component parts in many IC card embodiments can be considered functionally equivalent to one of ordinary skill in the art.

10 The amended claims and remarks describing these elements have been fully considered, but they are not persuasive, and therefore, the Examiner has made this Office Action final.

Conclusion

15 **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after
20 the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 2876

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Ahshik Kim* whose telephone number is (703)305-5203 . The examiner can normally be reached between the hours of 6:00AM to 3:00PM Monday thru Friday.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (703) 305-3503. The fax number directly to the Examiner is (703) 746-4782. The fax phone number for this Group is (703)308-7722, (703)308-7724, or (703)308-7382.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

Ahshik Kim
Patent Examiner
Art Unit 2876
February 4, 2003


MICHAEL G. LEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800